

## REMARKS

Applicants sincerely appreciate the thorough examination of the present application as evidenced by the Office Action of August 31, 2010 (hereinafter "Office Action"). In response, Applicants have amended Claims 1 and 22.

In the following remarks, Applicants will show that all claims are patentable over the cited art. Accordingly, a Notice of Allowance is respectfully requested in due course.

### **Independent Claims 1 and 22 Are Patentable over Saito and MacInnis**

Claims 1, 2, 4, 6, 7 and 9-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,987,767 to Saito (hereinafter "Saito") in view of U.S. Patent No. 6,853,385 to MacInnis et al. ("MacInnis"). (Office Action, page 3.) Applicants respectfully traverse the rejections as Saito and MacInnis, alone or in combination, fail to disclose or suggest several of the recitations of amended independent Claims 1 and 22 of the present application.

Amended Claim 1, for example, recites:

1. A method of forming an output media stream to be transmitted during a communication session from a portable communication device wherein said output media stream comprises signals of a first media type, the method comprising:

generating in real time a first media stream in the portable communication device,

combining in real time the first media stream with a second media stream to form the output media stream wherein combining comprises **superposing, within the portable communication device, signals of the first media type from the first media stream on signals of the first media type from the second media stream** to produce the output media stream, wherein the output media stream comprises portions of the first and second media streams which are configured to be presented in a substantially simultaneous time period, and

transmitting said output media stream,  
wherein **the communication session includes a video telephony session,**

wherein **the second media stream includes a prerecorded media stream that is user selectable,** and

**wherein at least one of generating and/or combining is dependent on input data from a user of said portable communication device.**

*(Emphasis added).*

In support of the rejection of Claim 1, the Office Action concedes that Saito does not disclose "superposing signals of the first media type from the first media stream on signals of the first media type on the second media stream" and alleges that MacInnis discloses "combining audio, graphics, and video transport streams into blended output streams." (Office Action, page 4.) The Office Action further alleges that the MPEG transport streams as taught by Saito can be superimposed into an output stream using the system as taught by MacInnis and that the motivation to do so is to "reduce the cost of the system by integration of hardware functions, efficient use of memory and efficient utilization of CPU activity." (Office Action, page 5.)

As an initial matter, Applicants note that the present invention is directed to portable communication devices. In contrast, MacInnis appears to describe a video and graphics system used in television control electronics, such as set top boxes, etc., which is a non-analogous art relative to portable communication devices. Accordingly, Applicants respectfully submit that the Office Action allegation that "superimposing" would improve system performance appears to be unrelated to the recitations of Claim 1, which generally disclose new functionality in a portable device. The Office Action statement is conclusory and without support in the record. For example, the references and the Office Action are wholly silent as to how "superposing signals" would improve system performance.

As is well-established law, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. (*KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).) Additionally, as was recently articulated, generic benefit is not sufficient motivation to combine references. (See *Ex parte Elliot N. Linzer*, BPAI Appeal 2009-001858, May 28, 2010.)

Applicants further note that Claim 1 includes recitations clarifying that the superposing is performed "within the portable communication device." In this regard, the teachings of MacInnis are even further attenuated relative to the claim recitations and thus even more non-analogous.

Additionally, Claim 1 is amended to recite that "the second media stream includes a prerecorded media stream that is user selectable." Support for this

amendment may be found in the Specification at least on page 10 in the paragraph beginning on line 40. For example, regarding some embodiments including this feature, the Specification states that "[1]s mixing is performed in real time 'on the fly' the receiving party might get the impression that the user is in another location than he actually is, like for instance on a luxurious vacation resort." (Specification, page 10, lines 42-44.) Applicants note that Saito and MacInnis, alone or in combination, do not disclose or suggest that the second media stream is prerecorded, much less that it is prerecorded and user selectable.

Yet further, Claim 1 is amended to recite that the communication session includes a video telephony session. Applicants respectfully submit that Saito and MacInnis are both wholly silent as to a video telephony session. Accordingly, Saito and MacInnis, alone or in combination, do not disclose or suggest "wherein the communication session includes a video telephony session," as recited in Claim 1, as amended.

Accordingly, Applicants respectfully submit that Claim 1, as amended, is patentable over Saito and MacInnis, alone or in combination, the allowance of which is respectfully requested.

Likewise, amended Claim 22 includes system recitations corresponding to the methods of Claim 1 and is thus patentable for at least similar reasons.

#### **Dependent Claims are Patentable**

Applicants respectfully submit that the dependent Claims 2, 4, 5, 7, 9-21, 23-29, 30 and 31 are patentable at least per the patentability of Claims 1 and 22 from which they depend. Applicants further submit that various dependent claims are separately patentable.

For example, Claim 15 recites, in part, "superposing the first and second audio signals of the first and second media streams." As discussed above, superposing is a specific form of combining that is not disclosed or suggested in Saito. For example, superpose may be defined as to place or lay over or above whether in or not in contact. (*See, e.g., Superpose, Merriam-Webster Online Dictionary*, Retrieved July 20, 2009, from <http://www.merriam-webster.com/dictionary/superpose>.) In contrast with the recitations of Claim 15, Saito discusses multiplexing packetized streams

**sequentially** in one stream, in contrast with **superposing** multiple signals into one stream so that at least a portion of the signals are configured to display at a substantially simultaneous time period. (Saito, Fig. 6; Saito, column 4 lines 40-67, column 5 lines 1-3 (each elementary stream is packetized into a PES, which is multiplexed with an identification code (PID) into the transport stream).) Accordingly, Saito's discussion of packetizing the elementary streams and multiplexing the packets into a transport stream does not disclose or suggest superposing streams into one stream. Accordingly, Claim 15 is separately patentable over the art of record, the allowance of which is respectfully requested.

### CONCLUSION

Accordingly, Applicants submit that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any small matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,



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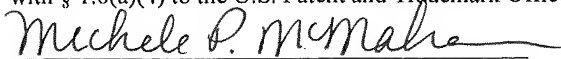
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### CERTIFICATION OF TRANSMISSION

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